

REMARKS

Applicants greatly appreciate the consideration of Applicant's previous response and the withdrawal of the previous rejections. Applicants respectfully request reconsideration of the new rejections and submit the claims are allowable for the following reasons.

Applicants hereby add new claims 39-42. Accordingly, claims 1-42 are pending in the present application.

Claims 1, 3-8, 10-15, 17, and 23-38 stand rejected under 35 USC 102(e) for anticipation by U.S. Patent No. 6,892,317 B1 to Sampath et al. Claims 2, 9, 16 and 22 stand rejected under 35 USC 103(a) for obviousness over Sampath in view of Hitachi Koko Imaging Solutions, Inc.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to the anticipation rejections, Applicant notes the requirements of MPEP §2131 (8th ed., rev. 3), which states that TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Referring to claim 1, the Office relies upon the teachings of col. 10 of Sampath as allegedly disclosing the claimed combining. Applicants respectfully disagree.

The combining of claim 1 recites combining a unique device identifier relevant to the peripheral device with a status change to form an electronic message. The Office on page 3 of the Action relies upon the teachings of col. 10, lines 28-30 as allegedly disclosing the claimed combining and which provide that a determined diagnosis event and job identifier are acquired for repair planning. Initially, Applicants note that the mere *acquisition* of the determined diagnosis event and job identifier fail to disclose or suggest any combining, let alone the combining to form an electronic message.

Furthermore, the teachings in col. 10 refer to acquiring a job identifier which is issued *after a job is completed responsive to a job request*. The job identifier of Sampath fails to disclose or suggest a unique device identifier as positively recited in claim 1.

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Furthermore, the teachings in col. 10 fail to disclose or suggest the combination of the identifier with a status change. More specifically, the Office at page 3 identified the teachings of Sampath at col. 5, lines 61-64 as allegedly disclosing the claimed determining that a status change has occurred in the peripheral device. The teachings in col. 5 refer to receiving *status information* from a monitored electronic system. There is no evidence of record that the mere providing of status information teaches determining that a *status change has occurred in the peripheral device*.

In addition, Applicants have failed to uncover any teachings in col. 10, lines 28-30 of Sampath that *the status information of col. 5 identified as allegedly disclosing the status change is combined with anything let alone the specifically claimed combining of the status change with the unique device identifier*.

Finally, the generic teachings of firewalls of col. 2 fails to disclose or suggest the limitations of *transmitting the electronic message formed by the unique device identifier and the status change across the firewall* as defined in claim 1.

As set forth above, numerous positively-recited limitations of the claims are not disclosed nor suggested by the prior art. Accordingly, in view of the above authority, the Office has failed to provide a proper anticipation rejection of the claims and the claims are in condition for allowance for the above-mentioned compelling reasons.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to dependent claim 28, the Office relies upon the teachings in col. 5, lines 61-62 and col. 6, lines 10-13 in support of the rejection. The reliance is misplaced. More specifically, the teachings of col. 5 refer to *prediction/diagnostic circuit 150 which is a component of the diagnostic server 100 as shown in Fig. 1 as opposed to monitored systems 200 or any other structure which may be fairly considered to disclose or suggest a peripheral device*. The teachings relied upon by the Office fail to disclose or suggest the claimed *combining of the unique device identifier with the status change using the peripheral device*. Furthermore, the teachings in col. 6 merely generically refer to status data that indicates one or more electronic systems have failed and any additional related device status information and fails to disclose the claimed combining recited in claim 28 using the peripheral device.

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Further, the teachings relied upon in col. 6 pertain to the repair planning circuit 165 which again is a component of the diagnostic server 100 as shown in Fig. 1. The combining using the peripheral device is not disclosed nor suggested by the prior art and claim 28 is allowable for at least this reason.

The Office appears to rely on "feedback diagnostic data" in support of the rejection as set forth on page 6 of the Office Action. However, Applicants have failed to uncover any teachings of "feedback" in cols. 5 or 6. Applicants respectfully submit the teachings of prior art Sampath reference fail to disclose or suggest limitations of claim 28.

Referring to dependent claim 29, the Office relies upon the teachings of col. 5, lines 61-62 and col. 6, lines 10-13 of Sampath in support of the rejection of claim 29. However, the discussions of circuits 150 and 165 of cols. 5 and 6 refer to circuits of the diagnostic server 100 as opposed to monitored systems 200 or any other structure which may be fairly considered to disclose or suggest a peripheral device. The operations of the diagnostic server fail to disclose or suggest the claimed *transmitting using the peripheral device* and claim 29 is allowable.

Also with respect to the rejection of claim 29, Applicants have failed to uncover any teachings of "feedback diagnostic data" in the teachings of cols. 5 and 6. Applicants respectfully submit the teachings of prior art Sampath reference fail to disclose or suggest limitations of claim 29.

Referring to page 7 of the Action, the Office appears to rely upon inherency in support of the rejection of claim 29. For proper reliance upon inherency, the Office must provide a basis in fact and/or technical reasoning to reasonably support the determination that the *allegedly inherent characteristics necessarily flow from the teachings of the applied prior art*. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The limitations of transmission of the electronic message formed by combining the unique device identifier with the status change using the peripheral device do not necessarily flow from the teachings of Sampath and the reliance upon inherency is improper. Limitations of claim 29 are not disclosed nor suggested by the prior art and claim 29 is allowable for at least this reason.

Referring to dependent claim 30, the Office relies upon teachings of the *diagnostic server 100* routing an action request for service. However, the routing by the diagnostic server 100 fails to disclose or suggest *the transmission of the order using*

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the peripheral device as positively claimed in claim 30.

Referring to dependent claim 32, the teachings of cols. 5 and 6 of Sampath fail to disclose or suggest the claimed combining and transmitting using the peripheral device. Further, the limitations have not been properly demonstrated to be inherent from the teachings of Sampath. The rejection of claim 32 is in error.

Referring to dependent claim 33, the teachings of cols. 5 and 6 of Sampath fail to disclose or suggest the claimed *transmitting responsive to the determining that the status change has occurred*. Further, the limitations have not been properly demonstrated to be inherent from the teachings of Sampath. The rejection of claim 33 is in error.

Referring to the rejection of claim 35, Sampath fails to disclose or suggest the claimed *computer usable medium in communication with the processor of a peripheral device to cause the processor of the peripheral device to perform the claimed determination, combination and transmission*. The generic interrogation commands and control signals of col. 9 of Sampath fail to disclose the limitations with respect to the *processor of the peripheral device* or the medium in communication with the processor of the peripheral device and configured to cause the processor of the peripheral device to perform the claimed determination, combination and transmission. Further, operations of the *server 200* of Sampath fail to disclose or suggest the limitations with respect to the *processor of the peripheral device* of claim 35 and claim 35 is allowable.

Claim 36 positively defines the processing circuitry of claim 15 comprises *processing circuitry of a hard copy output engine*. The teachings of cols. 5, 6, and 9 of Sampath relied upon by the Office fail to disclose the claimed *processing circuitry of the hard copy output engine performing the positively claimed determination, combination or transmission*. Further, the Office has failed to demonstrate that the limitations of processing circuitry of the hard copy output engine performing the claimed determination, combination, or transmission necessarily flow from any teachings of Sampath, and accordingly, any reliance upon inherency is improper. Applicants respectfully submit the rejection of claim 36 is improper for at least the above-identified compelling reasons.

Referring to claim 37, the Office relies upon the teachings of Fig. 1 of Sampath and monitored electronic system 200 thereof as allegedly teaching the claimed processing circuitry of the hard copy output engine. However, Applicants have failed to

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uncover any teachings of controller 220 or other components of system 200 being configured to perform the claimed determination, combination or transmission. Positively recited limitations of claim 37 are not disclosed nor suggested by the prior art and claim 37 is allowable for at least this reason.

Referring to claim 8, Applicants have failed to uncover any teachings in the prior art of the claimed medium having computer readable code embodied therein that is configured to cause a processor to performed the claimed determination, combination or transmission. Positively recited limitations of claim 8 are not disclosed nor suggested by the prior art and claim 8 is allowable for at least this reason.

The claims which depend from independent claim 8 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 15, Applicants have failed to uncover any teachings in the prior art of the claimed processing circuitry performing the claimed determination, combination or transmission. Positively recited limitations of claim 15 are not disclosed nor suggested by the prior art and claim 15 is allowable for at least this reason.

The claims which depend from independent claim 15 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 21, Applicants have failed to uncover any teachings in the prior art of the claimed signal carrying instructions that when executed cause a processor to performed the claimed determination, combination or transmission. Positively recited limitations of claim 21 are not disclosed nor suggested by the prior art and claim 21 is allowable for at least this reason.

The claims which depend from independent claim 21 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants have identified herein numerous claimed limitations which are not disclosed nor suggested by the teachings of the prior art identified by the Office. In the event that a rejection of the claims is maintained with respect to the prior art, or a new

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rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable*. Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a *non-final Action* if any claims are not found to be allowable.

Applicants submit herewith new claims 39-42 which are supported at least by the teachings at Figs. 1, 6 and 7 of the originally-filed application.

Applicants submit herewith a copy of a previously filed form 1449 which includes references thereon which have not been initialed by the Examiner. Applicants respectfully request forwarding of the initialed form indicating full consideration of the references thereon.


Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

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